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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,439	08/30/2001	Oral Fatih Sekendur		7902

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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 12/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,439

Applicant(s)

SEKENDUR, ORAL FATIH

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Objection to Duplicate Claims

Claims 8 and 12 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 2 and 6, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See M.P.E.P. § 706.03(k).

Applicant has indicated that upon approval or conference the present claims would be amended to overcome the objections. If applicant does not understand the objection, then the examiner is certainly willing to further explain the objection, if applicant disagrees with the objection, then the examiner is certainly willing to consider applicant's remarks and reconsider the objection. Otherwise, applicant is encouraged to fix the problem.

Rejection based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (US 1,040,972).

Alexander provides for a working platform, the patient's mouth (page 1, lines 86-91), and a formable metal of metallic fibers (page 1, lines 32-35), which is shaped on the working platform. After shaping the formed metallic fibers are apparently removed from the platform and a solder joining means is employed between the fibers for forming a solid rigid metallic dental structure (page 1, lines 102-106). The Alexander prosthesis is then inherently "finished" - removed from mold and prepared for insertion in the patient's mouth.

In response to the present rejection based on Alexander, applicant argues that Alexander discloses the use of a waxy lubricant on the metallic fibers which is dissipated by heat prior to the application of the solder and that his invention does not comprise such a lubricant. It is noted that applicant's claims do not present any such distinction. They are written broadly to include formable fiber masses that have a lubricant coating and formable fiber masses that do not.

Even if the claims were amended to exclude from within their scope formable fiber masses that had lubricant coatings, then it still does not appear that patentable subject matter is presented. More particularly, the elimination of an element (the lubricant) and the subsequent loss of its function (helping to hold the fibers in union and prevent adhesion (page 1, lines 35-37)) is generally considered to be obvious to the ordinarily skilled artisan and not patentable. Moreover, there are other previously cited references (Meisel (4,867,683), Kobashigawa et al (5,829,979), Karmaker et al (6,030,220) and Prasad et al (6,200,136 B1)) who show fiber dental systems where fillers (joining means) are employed between shaped fibers that have no lubricant coating.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoher et al (5,234,343).

Shoher et al disclose providing a model working platform ("die") Figure 2, providing a formable metal (high fusing temperature metal particles), providing a joining means (low fusing temperature metal particles), shaping the formable model on the working platform (Figure 2), joining the formable metal with low temperature fusing metal by heat treating and then finishing the dental prosthesis by providing for an out tooth like layer (column 1, lines 15-22).

In response to the present rejection applicant argues that the metal particles of Shoher et al do not meet the "formable metal" limitation because it is the wax binder holding the metallic particles which is being formed and shaped and not the particles themselves. The examiner notes, however, that applicant's claims expressly indicate that the formable metal may be "a paste of flux and metal powder" claim 5 which appears to this examiner to be what Shoher et al describe.

Applicant does not explain how his "paste of flux and metal powder" is any different from the moldable wax binder of metal particles of Shoher et al. Applicant argues that Shoher et al does not disclose metal screens, meshes or fibers. The examiner agrees. However, the claims explicitly require that a "paste of flux and metal particles" meet the "formable metal" limitation. The examiner is of the position that if a "paste of flux and metal powder" meets the "formable metal" limitation, then so does the moldable wax binder of metal particles disclosed by Shorer et al. Applicant argues that it is the wax of Shorer et al that is formable, not the metal particles; it is unclear to this examiner how applicant's metal powder is formable under such a definition and not the Shorer et al metal particles.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (US 1,040,972) in view of Shoher et al (5,234,343).

Alexander does not explicitly disclose how the formed dental prosthesis is finished, but one of ordinary skill in the art would readily recognize that at the very least it is polished and cleaned. Furthermore, the ordinarily skilled artisan would readily recognize that such prostheses are typically finished by providing for an outer porcelain or acrylic layer in order to improve the aesthetics of the prosthesis as taught by Shoher et al (column 1, lines 18). To have improved the aesthetics of the Alexander prosthesis by providing for a typical outer tooth-like layer would have been obvious to one of ordinary skill in the art.

Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoher et al (5,234,343).

In regard to claim 14, Shoher et al does not explicitly state that the resulting prosthesis is cemented to a patient's tooth with a flowable cement. For purposes of the rejection based on 35 U.S.C. 102 such a step is considered to be inherent in the use of the Shoher prosthesis. To the extent that such a use is not inherent in the teachings of the reference one of ordinary skill in the art would have readily recognized such a conventional manner in attaching the prosthesis as being obvious.

Applicant's Request that the Examiner Write Allowable Claims

Applicant's request that the examiner draft allowable claims is noted and after serious consideration and study the examiner is at a loss to provide for any meaningful suggestions in distinguishing the disclosed invention from the prior art. As the rejections indicate, even if applicant were to limit the claims to formable metallic fibers, then the invention is pretty much met by Jackson (1,040,972). Attention is also drawn to Meisel (4,867,683) who discloses the use of formable metal screen/ mesh/fabric which is formed into a bridge and filled with a joining means to form a solid bridge prosthesis. Finally attention is also directed to the prior art of Kobashigawa et al (5,829,979), Karmaker et al (6,030,220) and Prasad et al (6,200,136 B1). If applicant can provide a clear discussion and indicate how his invention is directed to specific ideas that are not previously known in the art, then the examiner will certainly work with him in properly claiming such subject matter, but as it stands the examiner fails to see or appreciate any patentable distinctions.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis
November 13, 2003



Ralph A. Lewis
Primary Examiner
Au3732